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PATENT  
674509-2028

1761#  
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Jørn Borch SØE  
U.S. Serial No. : 09/750,990  
Filing Date : December 28, 2000  
For : FOODSTUFF  
Examiner : Keith D. Hendricks  
Art Unit : 1761

745 Fifth Avenue, New York, NY 10151

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Date of Deposit: December 10, 2004

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Adam Ahmed  
(Typed or printed name of person mailing paper or fee)

N. J. J.  
(Signature of person mailing paper or fee)

**PETITION FOR WITHDRAWAL OF SPECIES ELECTION REQUIREMENT**

**ATTN: SPE CHRISTINE TIERNEY**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22303-1450

Dear Sir:

This paper is being filed simultaneous with a Response to Election of Species Requirement and Request for Extension of Time and is in response to the Office Action mailed August 25, 2004 which required an election of species, and this paper is further to the October 29, 2004 telephone conversation between SPE Tierney and the undersigned. Reconsideration and withdrawal of the election of species requirement is respectfully requested, and is requested in the accompanying Amendment. This paper is being filed for review of the election of species requirement in the event it is not reconsidered and withdrawn as herein requested and as requested in the accompanying Response. It is respectfully requested that this Petition be considered in conjunction with the accompanying Response, e.g., as this paper incorporates by

reference the accompanying Response, it is urged that the text of the accompanying Response be considered as if set out herein and be considered along with the text herein.

### **FACTS, ARGUMENT AND RELIEF REQUESTED**

#### ***Introduction and relief requested***

Applicants hereby petition for reconsideration and withdrawal of the election of species requirement.

Simply, reconsideration and withdrawal of the election of species requirement, is respectfully requested in view of the remarks herewith and those in the accompanying Response.

In short, reconsideration and withdrawal of the election of species requirement, as suggested in the accompanying Response, is respectfully requested because the election of species requirement restricts claims that were not previously subject to an election of species requirement, and that were previously searched and examined in their entirety.

More specifically, the election of species requirement divides claims on the basis of the type of foodstuff being claimed, whereas previously claims directed to foodstuffs in general were searched and examined.

Moreover, the claims set forth in the present invention at the time of filing related to a process for preparing a foodstuff, wherein a markush group listing types of foodstuffs was included in a dependent claim. The first Office Action that issued in respect to this application did not require an election of species among the types of foodstuffs listed in the markush group, and it appears that all of those listed were searched and examined. Instead, the term “foodstuff” was rejected as being unclear.

The second Office Action mailed October 22, 2002, again did not require an election of species, and all of the types of foodstuffs listed in the dependent claims were again searched and examined. Applicants hereafter filed a Request for Continued Examination, and a third Office Action issued on May 6, 2003, which again did not require an election of species. In fact, the third Office Action contained a rejection that applied only to those claims which included the recitation of “baked goods” thereby demonstrating that the various types of foodstuffs were being examined.

The fourth Office Action was mailed on December 4, 2003, which again included rejections involving only specific elements of foodstuffs, in this case oils, which again demonstrate that the application was being searched and examined as a whole.

Applicants again filed a Request for Continued Examination which included a preliminary amendment which set forth the markush group providing the various types of foodstuffs in the independent claim, as was suggested by the Examiner during a telephonic interview. The following Office Action, that which was mailed on August 25, 2004, contained the requirement for election of species as required above.

Applicants believe that the prior search and examination of all of the alleged species while they were set forth in a markush group in a dependent claim requires that the claims continue to be searched and examined as a whole. It is respectfully asserted that the movement of a markush group from a dependent claim into an independent claim is not proper basis for an election of species requirement, especially when the claims have been previously searched and examined as a whole, have been subject to four prior office action and wherein two Requests for Continued Examination have been filed.

#### **REMARKS**

The Office Action mailed August 25, 2004 required election of a single species as set forth by the Office Action in the following Groups:

- i. sweets group, recited as “candy, caramel, chocolate, pudding, halawa, [and] gum” in claims 70 and 75-79;
- ii. dairy products, including pudding and frozen dairy products, as recited in claims 70-73 and 75-79;
- iii. baked goods, as recited in claims 70 and 75-79;
- iv. meat products, as recited in claims 70, 75 and 75-79;
- v. oils/fats group, recited as “edible oils, edible fats, oil-in-water emulsions, water-in-oil emulsions . . . margarine, shortening, [and] spreads” in claims 70 and 75-79;
- vi. sauces group, recited as “spreads, mayonnaise, dips, cream based sauces, cream based soups . . . spice emulsions, and sauces” in claims 70 and 75-79;
- vii. beverages, as recited in claims 70 and 75-79; and,
- viii. frozen products, as recited in claims 70 and 75-79.

Applicants hereby protest the election of species requirement on the basis that the present application has been the subject of four previous Office Actions, all of which involved the search

and examination of all of the foodstuffs described above which were separated into alleged groups of species for the first time in the Office Action dated August 25, 2004, which was the fifth Office Action issued in the present application.

Previous versions of the claims included the recitation “foodstuffs” in the independent claim, and the types of foodstuffs was set forth in a markush group within dependent claims. Further to a telephonic interview between Examiner Hendricks and Angela Collison, the markush groups was moved into the independent claim at the suggestion of Examiner Hendricks. The paper which made this amendment to the claims was immediately followed by the August 25, 2004 Office Action which required restriction from among the items listed in the markush group.

Applicants respectfully assert that the movement of a markush group from a dependent claim into an independent claim is not grounds for an election of species requirement, especially when the claims were previously searched and examined as a whole and were subjected to four separate Office Action which considered the claims in their entirety.

Accordingly, Applicants hereby petition for the reconsideration and withdrawal of the election of species. The enforcement of the election of species will result in undue prejudice to Applicants, especially in the form of shortened patent life for any divisional applications filed to cover the remaining species. Such prejudice and hardship will be especially undue as the prosecution of the present application has been ongoing for approximately four years prior to the issuance of the election of species requirement.

**CONCLUSION**

Reconsideration and withdrawal of the restriction requirement, is respectfully requested, especially as the separation of claims on the basis of type of foodstuff is untenable and can not be supported by the facts, the law, or the knowledge in the art.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

A handwritten signature in black ink, appearing to read "Thomas J. Kowalski", is written over a horizontal line.

Thomas J. Kowalski

Reg. No. 32,147

Angela M. Collison

Reg. No. 51,107

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Adam Ahmed  
(Typed or printed name of person mailing paper or fee)

A. Ahmed  
(Signature of person mailing paper or fee)

**RESPONSE TO ELECTION OF SPECIES REQUIREMENT  
AND REQUEST FOR EXTENSION OF TIME**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22303-1450

Dear Sir:

This paper is being filed in response to the Office Action mailed August 25, 2004 which required an election of species and set a one-month period of time for reply, and this paper is further to the October 29, 2004 telephone conversation between SPE Tierney and the undersigned. Applicants elect, with traverse, the species of the oils/fats group.

Pursuant to 37 C.F.R. §§1.136(a) and 1.17(a), it is respectfully requested that the period for reply be extended three months, i.e., up to and including December 25, 2004. Enclosed herewith is a check in the amount of \$1020.00 in payment of the fee therefore. The Commissioner is hereby authorized to charge any additional fee, or credit any overpayment, to Deposit Account 50-0320.

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**REMARKS**

The Office Action mailed August 25, 2004 required election of a single species as set forth by the Office Action in the following Groups:

- i. sweets group, recited as “candy, caramel, chocolate, pudding, halawa, [and] gum” in claims 70 and 75-79;
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- v. oils/fats group, recited as “edible oils, edible fats, oil-in-water emulsions, water-in-oil emulsions . . . margarine, shortening, [and] spreads” in claims 70 and 75-79;
- vi. sauces group, recited as “spreads, mayonnaise, dips, cream based sauces, cream based soups . . . spice emulsions, and sauces” in claims 70 and 75-79;
- vii. beverages, as recited in claims 70 and 75-79; and,
- viii. frozen products, as recited in claims 70 and 75-79.

Applicants elect, with traverse, the group of oils/fats.

Initially, Applicants assert that an election of species is required under M.P.E.P.

§808.01(a) “where there is no disclosure of relationship between species (*see* M.P.E.P. §806.04 (b)), they are independent inventions and election of one invention”. In view of M.P.E.P. §803, however, when the generic claim includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the examiner, then a requirement for election is inappropriate.

It is respectfully submitted there is a disclosure of relationship between the claimed species. The species are all varieties of foodstuffs, and in fact, during portions of the prosecution of this application so far, have been claimed collectively as foodstuffs. Consequently, there is a disclosed relationship between the groups.

Furthermore, the Office Action has made no showing that searching all of the species of foodstuffs would constitute an undue burden. Indeed, the present application has been the subject of four previous Office Actions, all of which involved the search and examination of all of the foodstuffs described above which were separated into alleged groups of species for the first time in the Office Action dated August 25, 2004, which was the fifth Office Action issued in the present application.

Initially, the claims set forth in the present invention at the time of filing related to a process for preparing a foodstuff, wherein a markush group listing types of foodstuffs was included in a dependent claim. The first Office Action that issued in respect to this application did not require an election of species among the types of foodstuffs listed in the markush group, and it appears that all of those listed were searched and examined. Instead, the term “foodstuff” was rejected as being unclear.

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Applicants believe that the prior search and examination of all of the alleged species while they were set forth in a markush group in a dependent claim requires that the claims continue to be searched and examined as a whole. It is respectfully asserted that the movement of a markush group from a dependent claim into an independent claim is not proper basis for an election of species requirement, especially when the claims have been previously searched and examined as a whole, have been subject to four prior office action and wherein two Requests for Continued Examination have been filed.

In summary, enforcing the present election of species requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, whereby a shortened patent term

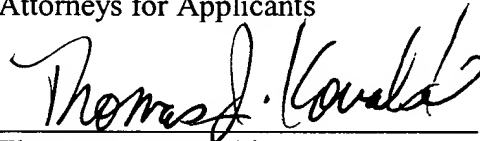


may result in any divisional applications filed, especially as the election of species requirement has only been issued four years into prosecution of the application). Restriction to a single species has not been shown to be proper, especially since it has been shown that the requisite showing of serious burden has not been made. Indeed, the search and examination of each species would be likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner, as was the case when the first four Office Actions were issued in this application. All of the preceding, therefore, mitigate against restriction to a single species.

Consequently, reconsideration and withdrawal of the election of species requirement is respectfully requested.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

A handwritten signature in black ink, appearing to read "Thomas J. Kowalski", written over a horizontal line.

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